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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,625	07/16/2003	Hsiu-Ching Huang	4458-0114P	7294
2292	7590	08/30/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			SMITH, JAMES G	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 08/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/619,625	HUANG, HSIU-CHING	
	Examiner	Art Unit	
	James G. Smith	3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

It appears that the submitted priority document is not to the same invention as the present application.

Specification

2. The disclosure is objected to because of the following informalities: lines 23-25 on page 5 continuing on page 6 appear to be incorrect as they describe a movement that does not occur, i.e. the wall of the controller moving when it would be the wall of the arched recess that moves away from the claw.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims fail to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

The claims also appear to be drawn to a wrench per se, however they contain method steps, implying that they are product by process type claims, or some type of hybrid of an apparatus and method of making the tool, e.g. "two claws put in the recess and a spring put between the claws" in claim 1.

There is also no antecedent basis for "the annular gear" in claim 1.

Further, the embodiments claimed in claims 9 and 10 are not supported by the specification or drawings.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 4-10 of copending Application No. 10/454,196 in view of Chen. The difference between the two applications of applicant is the use of second rods to secure the spring instead of an opening in the claws, however the use of such openings is well known in this type of wrench for the same purpose as clearly suggested by the Chen reference.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Arnold et. al. and Lin (442 or 825).

Chen shows the claimed invention except for the use of a channel extending from the circular space to the pothole to allow for easier access of the claws when assembling the tool and the use of "second rods" to aid in securing the spring and preventing "grid lock" of the claws. Arnold et. al. suggests that a ratchet wrench can have a "channel" between the circular space containing the gear and the pothole containing the clutch and claws and therefore allows for easier assembly of the tool elements. It would therefore be obvious to one skilled in the art at the time the invention was made to modify Chen by using a channel in the head because Arnold et. al. suggests the use of such a channel for the purpose stated by applicant, i.e. to allow for easier assembly of the tool.

Further, Lin (442 or 825) suggest that one manner of securing the spring between the claws in the use of "second rods" and that these rods also prevent "grid

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lock” of the claws. It would therefore be obvious to one skilled in the art at the time the invention was made to modify Chen by using second rods on the claws to secure the spring and prevent “grid lock” of the claws because either Lin (442 or 825) suggest the use of such second rods for the purpose of preventing “grid lock” of the claws and securing the spring.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Arnold et. al. and Lin (442 or 825) as applied to claims 1-7 and 10 above, and further in view of Lack.

Chen, as modified by Arnold et. al. and Lin (442 or 825) above, shows the claimed invention except for the method of attaching the controller, i.e. a C-ring instead of a threaded bolt. Lack suggests that a ratchet wrench can have the controller attached by means of a resilient ring, of any shape, as an alternative type of attachment that is well known. It would therefore be obvious to one skilled in the art at the time the invention was made to modify Chen by using a resilient ring to attach the controller instead of a threaded bolt because Lack suggests the use of such a method of attaching a controller to a ratchet wrench and both methods are clearly well known.

10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Arnold et. al. and Lin (442 or 825) as applied to claims 1-7 and 10 above, and further in view of Stone.

Chen, as modified by Arnold et. al. and Lin (442 or 825) above, shows the claimed invention except for the method of attaching the controller, i.e. a C-clip and


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rod instead of a threaded bolt. Stone suggests that a ratchet wrench can have the controller attached by means of a C-clip and rod as an alternative type of attachment that is well known. It would therefore be obvious to one skilled in the art at the time the invention was made to modify Chen by using a C-clip and rod to attach the controller instead of a threaded bolt because Stone suggests the use of such a method of attaching a controller to a ratchet wrench and both methods are clearly well known.

11. The remaining prior art is cited only as of interest.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James G. Smith whose telephone number is 703-308-1746. The examiner can normally be reached on M-Th (7:05- 4:35) Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail, III can be reached on 703-308-2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James G. Smith

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Primary Examiner
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jgs
8/26/04